

Attorney Docket No.: DEX-0203
Inventors: Chen et al.
Serial No.: 09/820,425
Filing Date: March 29, 2001
Page 5

REMARKS

Claims 1-25 are pending in the instant application. Claims 7, 8 and 10-25 have been withdrawn from consideration by the Examiner and subsequently canceled without prejudice by Applicants in this amendment. Claims 1-6 and 9 have been rejected. Claims 1 and 9 have been amended and claims 5 and 6 have been canceled. Support for the amendments to the claims is provided in the specification at page 16, lines 13-18, page 20, lines 1-3, page 21, line 30, through page 22, line 3 and page 35, lines 7-9. Thus, no new matter is added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Finality of Restriction Requirement

The Restriction Requirement mailed December 31, 2002 has been made final. Accordingly, Applicants have canceled non-elected claims 7, 8 and 10-25, without prejudice. In light of the finality of this Restriction Requirement, Applicants reserve the right to file a divisional application to the canceled subject matter.

Attorney Docket No.: DEX-0203
Inventors: Chen et al.
Serial No.: 09/820,425
Filing Date: March 29, 2001
Page 6

II. Oath/Declaration

Applicants are providing herewith a newly executed Declaration with the correct filing date of U.S. Provisional Application 60/192,921.

III. Objection to Claims

Claims 1-6 and 9 have been objected to as not having been amended to reflect the election. Thus, in an earnest effort to advance the prosecution of this case, Applicants have amended the claims to be drawn to the elected subject matter. Withdrawal of this objection is therefore respectfully requested.

IV. Rejection of Claims 1-6 and 9 under 35 U.S.C. § 112, second paragraph

Claims 1-6 and 9 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Specifically, the Examiner suggests that claims 1-6 and 9 are confusing for recitation of either "a protein" or "LSG". The Examiner suggests that there are at least 6 possible polypeptides encoded by SEQ ID NO:12 and it is not clear which polypeptide the claim is referring to.

Attorney Docket No.: DEX-0203
Inventors: Chen et al.
Serial No.: 09/820,425
Filing Date: March 29, 2001
Page 7

Further, recitation in claim 1 of "the same protein" is suggested to lack antecedent basis.

Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have amended claim 1 and 9 to delete reference to proteins. Instead, claim 1, line 8, has been amended in accordance with teachings at page 16, lines 13-18 to state that the polynucleotide comprises nucleic acid sequence which, due to degeneracy in genetic coding, comprises silent variations in nucleotide sequence as compared to SEQ ID NO: 12 which do not alter any amino acids encoded thereby. Claims 5 and 6 stating LSG polypeptide have been canceled. Further, the term "LSG" in claim 9 has been replaced with the phrase "cancer marker" in accordance with teachings at page 35, lines 7-9.

Withdrawal of this rejection under 35 U.S.C. § 112, first paragraph, is therefore respectfully requested.

V. Rejection of Claim 1-6 and 9 under 35 U.S.C. § 112, first paragraph

Claims 1-6 and 9 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner suggests that the specification does not describe the chemical structure

Attorney Docket No.: DEX-0203
Inventors: Chen et al.
Serial No.: 09/820,425
Filing Date: March 29, 2001
Page 8

of the protein encoded by SEQ ID NO:12, thus failing to meet the written description requirement.

Applicants respectfully disagree with the Examiner as it is believed that the chemical structure of a protein encoded by SEQ ID NO:12 can be routinely determined from the teachings of instant specification.

However, in an earnest effort to advance the prosecution of this case, Applicants have deleted any reference to proteins from the claims.

Withdrawal of this rejection under 35 U.S.C. § 112, first paragraph is therefore respectfully requested.

VI. Rejection of Claims 1-6 and 9 under 35 U.S.C. § 102(b)

Claims 1-6 and 9 have been rejected under 35 U.S.C. § 102(b) as being anticipated by either U.S. Patent 5,559,026 or U.S. Patent 5,858,787. The Examiner suggests that these patents teach fragments of a nucleotide sequence comprising at least 15 contiguous nucleotides of SEQ ID NO:12 as claimed.

Accordingly, in an earnest effort to advance the prosecution of this case and in accordance with teachings of the specification at page 20, lines 1-3 and page 21, line 30, through page 22, line 3, regarding length of preferred fragments of the

Attorney Docket No.: DEX-0203
Inventors: Chen et al.
Serial No.: 09/820,425
Filing Date: March 29, 2001
Page 9

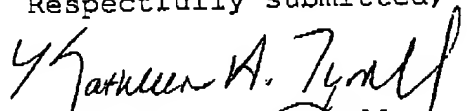
present invention, Applicants have amended the claims to clarify that fragments comprises at least 45 contiguous nucleobases of SEQ ID NO:12. As neither of the cited references teach fragment with 45 contiguous nucleobases of SEQ ID NO:12, these references cannot anticipate the claims as amended.

Withdrawal of this rejection under 35 U.S.C. § 102(b) is therefore respectfully requested.

VII. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,


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